

REMARKS

Applicants respectfully traverse and request reconsideration.

Claims 1-10 are allowed.

Claims 11, 13-21 and 23 stand rejected under 35 U.S.C. § 251 as allegedly being based upon a defective reissue due to an alleged defect in the supplemental oath/declaration. Applicants respectfully traverse since the submitted Supplemental Reissue Declaration was the form supplied by the Patent Office and specifically states as required by the MPEP that every error in the patent which was corrected in the present reissue application which is not covered by the prior oaths and/or declarations submitted in the application, was made without deceptive intention on the part of the Applicants. It appears that the Examiner believes that some additional language is required in a further supplemental declaration. If this position is maintained, Applicants respectfully request an indication of what language is needed in the supplemental declaration as the filed supplemental declaration is believed to be compliant with the rules of the U.S. Patent Office and the supplemental declaration used was the form provided by the U.S. Patent Office. Applicants can submit a new supplemental declaration upon notice of a statement of allowance for the pending claims to the extent necessary.

Claims 15, 16-18, 19-21 and 23 stand rejected under 35 U.S.C. 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicants respectfully submit that the claims are directed toward a different aspect of invention and the language identified by the Examiner was not argued to overcome the prior art references. Applicants respectfully traverse and respectfully note that the three step test as articulated in *In re Mostafazadeh*, 643 F.3d 1353, 1358 (Fed. Cir. 2011) must be used and all steps must be met before recapture can be found. The

first step is to determine whether and in what aspect the reissue claims are broader than the patent claims, the second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter, and the third step is to determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged and hence avoid the recapture rule.

It is alleged that the language “prior to, enabling CPU access” is allegedly not deemed to be removable from apparently any claims. However, Applicants respectfully note that the patent statute and the MPEP recognizes that the recapture rule does not apply to claims that are directed to other aspects of the invention where a patentee claims less than patentee has a right to claim in the original patent. The rule against recapture is not violated when the broadened subject matter is not related to the subject matter surrendered during prosecution. Moreover the rule does not apply to reissue claims directed to additional inventions, embodiments or species not originally claimed that are completely unrelated to the surrendered subject matter. In the instant case, Applicants respectfully submit that claim 15, for example (and other claims), is directed to the indication of protection that indicates one of a plurality of different types of data access which is not the subject of the prior allowed independent claims. Applicants respectfully submit that at least the second prong of the recapture test is not met since the claim is directed to a different aspect of the invention. Claim 15 is not directed to the “prior to, enabling CPU access” aspect of the invention but is directed to a different aspect of the invention and does not require the surrendered subject matter. Applicants are entitled to broaden claims and direct those broadened claims to aspects of the invention that were not previously claimed (such as in the combination set forth in claim 15). The language in claim 15 is new language that does not appear in original claims 1-10. Instead the different aspect, among other things, that is being addressed by this

claim is that the protection detection circuit detects the presence of the embedded data access parameter and provides an indication of protection based on the embedded data access parameter when the embedded data access parameter is detected wherein the indication or protection indicates one of a plurality of different types of data access. The claim is also directed to at least, for example, a central processing unit or another computer element and being responsive to the indication of protection from the protection circuit and operative to process the stored video data based on an indication of protection.

Alternatively or in addition to the argument above, Applicants invite the Examiner to reconsider the prosecution of the parent application in connection with the language “prior to enabling a signal processing unit to access the digital video” since this language was not argued to overcome rejections in view of prior art references as set forth, for example, in Applicants’ amendment August 7, 2001 and the amendment of January 4, 2000. In fact, the language that was argued in the August 7, 2001 response was different language in now claim 1 which is the language “digitizing...the at least one of audio and video data to produce digital video”. As set forth on page 5 of Applicants’ amendment, this different language was argued to show that the Kori reference described digitization of the input signals performed only in response to an analog copy protection value and that copy protection information if any is removed from the input signal before digitization. The language that was argued from the claim is the language “...independent of data access parameter...” of the claim and not the “prior to enabling a central processing unit to access the digital video” language as alleged by the Examiner. Accordingly, for this reason, it is clear that the Applicants arguments did not limit the scope of the terms in the claim to obtain a patent as to the terms “prior to, enabling CPU access” as is alleged by the office action. Accordingly, the recapture rule does not require such language to be in every claim. In

addition, Applicants are allowed to claim other aspects of the invention not believed to be included in the original claims if it was done so without any deceptive intent.

Also, Applicants invite the Examiner to consider Applicants' remarks in the response dated January 4, 2000, page 6 thereof wherein the arguments relating to why the Kanata reference was overcome, related to the fact that "Kanata does not teach or suggest preserving a data access parameter that is typically lost during normal operation of computer display video data, wherein the data access parameter...". It is further stated that "since Kanata fails to teach or suggest preserving a data access parameter that is typically lost in normal operation, combining that teaching with an interface [such as that from Kendall] does not render the present invention obvious" (page 6 of response). Again, Applicants did not argue or otherwise indicate that the claim overcame any prior art in view of the language such as "prior to, enabling CPU access". Accordingly, the recapture doctrine does not apply to this language for this reason as well. Applicants respectfully reassert the relevant remarks made above with respect to claim 19.

As to claim 23, Applicants also respectfully reassert the relevant remarks made above and note that this claim also is directed to a different aspect of the invention, namely the employment of different processing paths as well as controller and processor interaction. Accordingly, Applicants respectfully reconsideration and withdrawal of the rejection.

Applicants respectfully submit that the claims are now believed to be in condition for allowance and that a timely Notice of Allowance be issued in this case. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (312) 356-5094.

Respectfully submitted,

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